

REMARKS

It is noted that claims 1-14 and 16-36 are pending in the application. Claims 1-14 and 16-36 are rejected and Claim 25 is objected to.

CLAIM OBJECTIONS

Claim 25 was objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must recite the claims it depends from in the alternative. The Examiner suggested replacing "claims" with --claim--and that accordingly the claim has not been further treated on the merits.

With entry of the above amendment the applicants have amended claim 25 in accordance with the Examiner's suggestion. It is therefore respectfully submitted that the objection to claim 25 has been overcome and should be withdrawn.

CLAIM REJECTIONS - 35 USC §112

Claims 1-3, 6-11, 15, 17-19, 21-24, 29, 31-33, 35-39, and 43-48 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully submit that only claims 1-14 and 16-36 are in the present case. It is therefore respectfully requested that the rejection with regard to claims 37-39 and 43-48 be withdrawn.

More specifically, with regard to Claim 1, the Examiner has stated that "said admixture" lacks antecedent basis. The Examiner suggested that "said admixture" be replaced with --said particulate admixture--.

With entry of the above amendment applicants have amended claim 1 in accordance with the Examiner's suggestion. It is therefore, respectfully submitted that the rejection of claim 1 under 35 USC 112, second paragraph, has been overcome and should be withdrawn.

With regard to claim 6, the Examiner has stated that at line 8 that "the metal" lacks antecedent basis or that it is unclear which metal is being referred to.

With entry of the above amendment claim 6 has been amended to recite that the "transition metal" is chosen from the listed group. With entry of the term "transition" applicants believe the term has proper antecedent basis and is also clear as to which metal is being referred to. It is respectfully submitted, in view of this amendment, that the rejection of claim 6 under 35 USC 112, second paragraph, has been overcome and should be withdrawn.

With regard to claims 7, 31 and 35, the Examiner has stated that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The Examiner stated that claims 7, 31 and 35 recite the broad recitation "particulate reducing agent selected from the group consisting of" and that the claims then also recite "metals selected from the group consisting of", which the Examiner stated is the narrower statement of the range/limitation.

With entry of the above amendment claims 7, 31 and 35 have been amended with the deletion of the phrase "metals selected from the group consisting of" which the Examiner has stated is the narrower statement of the range limitation. Applicants respectfully submit that with entry of the above amendment that claims 7, 31 and 35 are definite and clearly set forth the metes and bounds which applicants regard as the invention and that the rejection of claims 7, 31 and 35 under 35 USC 112, second paragraph, has been overcome and should be withdrawn.

The Office Action states that Claim 9 appears to contain only product limitations and is unclear as to how it limits a process of making. The Office Action further states that "characterized by" is unclear as to whether the process actually contains the claimed structure or whether it may merely be characterized as such. The Examiner has suggested that "is characterized by" be replaced with --has a--.

With entry of the above amendment applicants have incorporated the Examiner's suggestion. It is therefore respectfully submitted that the rejection of Claim 9 under 35 USC 112, second paragraph has been overcome and should be withdrawn.

With regard to Claim 18, the Examiner pointed out that "the source of lithium ions" lacks antecedent basis. Applicants appreciate the Examiner's careful review of the claims and pointing out this inadvertent error. With entry of the above amendment applicants have removed the phrase "the source of lithium ions" and replaced it with "the lithium compound" which has antecedent basis in independent claim 1. Applicants therefore, respectfully submit, that the rejection of claim 18 under 35 USC 112, second paragraph, has been overcome and should be withdrawn.

With regard to Claim 37, the Examiner pointed out that "said heating" lacks antecedent basis. According to applicants' file there was not a Claim 37 filed with the preliminary amendment filed with the application. If there is a Claim 37 that needs further amendment the Examiner is requested to call the undersigned at 847-251-2326 and applicants will correct their file. Applicants respectfully submit, that the rejection of claim 37 under 35 USC 112, second paragraph, should be withdrawn.

Applicants respectfully submit that with entry of the above amendments and in view of these remarks that the rejection of claims 1, 6, 7, 9, 18, 31 and 35, under 35 USC 112, second

paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention has been overcome and should be withdrawn.

Claim Rejections – 35 USC §103

Claims 1-14 and 16-36 are rejected under 35 USC 103(a) as being unpatentable over Gaffar U.S. 4,427,652 in view of Westrate et al. U.S. 4,460,565. The Examiner states that with regard to claims 1, 19, 21 and 32 that Gaffar discloses a process for making a dental phosphate compound comprising reacting a phosphate compound, a metal compound, and a reducing agent, by admixing ingredients by milling at sufficient particle size and heating temperature. The Examiner further states that Gaffar fails to disclose a lithium compound to produce lithium metal phosphate.

The Office Action states that Westrate discloses lithium fluorophosphates and vanadium fluorophosphates. The Examiner has combined Gaffar and Westrate to say that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the lithium compound of Westrate to produce lithium vanadium fluorophosphates in the dental compound process of Gaffar because Westrate discloses both lithium and vanadium fluorophosphates consecutively as examples of suitable compounds in a process for making a compound capable of restoring carious tooth parts for use in toothpastes. Therefore, the Examiner states that such combination would obviously suggest, to one of ordinary skill, the combination of lithium vanadium fluorophosphates in a tooth paste compound.

Applicants respectfully point out that with entry of the above amendment the claims have been amended to recite that the process of the present invention is directed to a process for making electroactive materials. More specifically the claims recite that the materials produced by

the present process are useful for making electrodes for batteries or for making a cathode active material. Gaffar and Westrate are both directed to dental compounds and processes. Therefore, applicants respectfully submit that the present process, for preparing electroactive materials for use in making electrodes for batteries, would not have been obvious to one of ordinary skill in the electroactive art in view of Gaffar and Westrate at the time the invention was made. For this reason alone applicants believe that the rejection under 35 USC 103 has been overcome and should be withdrawn. However applicants will also address each reference individually and in combination in the following paragraphs.

Applicants point out that Gaffar discloses organic phosphonic acid derivatives, phosphonyls, phosphonyl fluorides and copolymers thereof. The compounds disclosed therein would not be useful in a process for preparing inorganic phosphate compounds which would be useful as electroactive materials. It is respectfully submitted that such organic phosphonyl compounds would not suggest to one of ordinary skill in the art a process for making the inorganic phosphate compounds of the present invention for use as electroactive materials. Furthermore, the compounds disclosed therein are useful in dental applications, and therefore the process of Gaffar, does not disclose or suggest the use of a transition metal in a process to make electroactive materials.

Westrate discloses a "vanadium fluorophosphate". However, there is no suggestion or disclosure of alkali transition metal fluorophosphates in Westrate. The present invention is directed to a process for preparing electroactive lithium transition metal phosphates which are useful in lithium ion cell applications. Materials that would be useful as electrodes in lithium ion cells would need the presence of both lithium (or another alkali metal) and a transition metal. There is no disclosure or suggestion of the same in Westrate.

Applicants further submit that there is no motivation within either Westrate or Gaffar which would motivate one to combine the process of Gaffar to use the organic compounds of Gaffar to produce a process for preparing electroactive lithium transition metal phosphates of the present invention. This is especially true in view of the fact that Gaffar and Westrate are both directed to the dental art, whereas applicants' invention is directed to electroactive materials useful in producing electrodes. The organic compounds of Westrate would not be useful in producing the compounds produced by the process of the present invention. Furthermore, there is no suggestion or explicit disclosure within either Gaffar or Westrate which would motivate one to even try and combine the compounds of Westrate in the process of Gaffar or any suggestion or disclosure of why the same would be desirable.

In view of the above amendment and these remarks applicants respectfully submit that the claims of the present invention are not obvious from Gaffar in view of Westrate et al. It is therefore respectfully submitted that the rejection of the claims under 35 USC 103(a) as being unpatentable over Gaffar in view of Westrate has been overcome and should be withdrawn.

Reconsideration of the claims in the instant case for allowance is respectfully requested in view of the above amendment and these remarks. It is respectfully submitted that all of the objections and rejections in the Official Action have been overcome and should be withdrawn. It is respectfully submitted that all of the claims in the case are allowable and passage of the application and claims to issue is respectfully requested.

Dated: 2/28/05
VALENCE TECHNOLOGY, INC.
301 Conestoga Way
Henderson, NV 89015
(702) 558-1000

Respectfully submitted,

By: Cynthia S. Kovacevic
Cynthia S. Kovacevic
Reg. No. 35,578
Attorney for Applicants